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10/569,864	02/27/2006	Yoshiko Kitagawa	44471/326578	9760
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JOHN S. PRATT, ESQ	KILPATRICK STOCKTON, LLP		SU, SARAH	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/569,864	Applicant(s) KITAGAWA ET AL.
	Examiner Sarah Su	Art Unit 2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 November 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) 1,7,9,11 and 15 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 February 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 2/27/06, 4/24/06, 1/21/09.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 17-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10 November 2008.
2. Claims 1-16 are presented for examination.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
4. The claim for priority from PCT/JP04/07112 filed on 19 May 2004 is duly noted.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The abstract of the disclosure is objected to because in line 8: "action requested, to a second" should read –action requested to a second–. Correction is required. See MPEP § 608.01(b).

8. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

9. The disclosure is objected to because of the following informalities:

- a. in page 14, line 15: "transmission destination server R40" should read – transmission destination server 40–;
- b. in page 39, line 18: "S303 through S209" should read –S303 through S309–;
- c. in page 46, line 19: "11a and 21" should read –11a and 11b–;
- d. in page 46, line 21: "12a and 22" should read –12a and 12b–;
- e. in page 89, line 11: "918" should read –S918–.

Appropriate correction is required.

Claim Objections

10. Claims 1, 7, 9, 11, and 15 are objected to because of the following informalities:
- a. In claim 1, line 3: "authentication information" is unclear if it relates to "authentication information" (claim 1, line 2);

- b. In claim 1, lines 18-19: "an image" is unclear if it relates to "an authentication image" (claim 1, line 8);
- c. In claim 7, line 2: "an authentication image" is unclear if it relates to "an authentication image" (claim 1, line 8);
- d. In claim 7, line 4: "communication terminal,." should read –communication terminal.–;
- e. In claim 9, line 3: "authentication information" is unclear if it relates to "authentication information" (claim 9, line 2);
- f. In claim 9, line 17: "an image" is unclear if it relates to "an authentication image" (claim 9, line 6);
- g. In claim 11, line 2: "an authentication image" is unclear if it relates to "an authentication image" (claim 9, line 6);
- h. In claim 15, line 2: "an authentication image" is unclear if it relates to "an authentication image" (claim 9, line 6);
- i. In claim 15, line 4: "communication terminal,." should read – communication terminal.–.

Appropriate correction is required.

Drawings

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 40 (Figure 1); 41 (Figure 10); S123 (Figure 11); S202, S209 (Figure 13);

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S301 (Figure 15); S353, S362 (Figure 16); S455 (Figure 20); 13a, 14a, 14b, 15b (Figures 21, 23); S716 (Figure 28); S808 (Figure 30); S815, S817, S818 (Figure 31); S909 (Figure 39); S919 (Figure 40).

12. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 311 (page 34, line 23); S302 (page 39, line 13).

13. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "S205" has been used to designate both PHOTOGRAPH AUTHENTICATION IMAGE (Figure 13) and PRESENT AUTHENTICATION IMAGE (Figure 15).

14. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "104" (page 44, line 17) and "S204" (Figure 20) have both been used to designate storing in reminder question and answer storage unit.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-2, 5-7, 9-10, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Saada et al. (US Patent 5,253,295 and Saada hereinafter).

As to claims 1 and 9, Saada discloses a system and method for authentication by an outside medium of a portable object, the system and method having:

an authentication information storage unit (i.e. control table)

configured to store the authentication information (col. 4, lines 43-44);

an authentication image generating module configured to generate an authentication parameter, generate an authentication image (i.e. result including the authentication parameter and transmit it to the communication terminal (col. 7, lines 38-42), and then store the authentication parameter in an authentication parameter storage unit upon reception of an authentication request for the communication terminal (col. 4, lines 38-40; col. 9, lines 66-68; col. 10, lines 1-3);

an authentication information acquiring module configured to acquire from the authentication terminal information of the authentication image acquired from the communication terminal and the authentication information stored in the authentication terminal (col. 10, lines 6-9, 32-36);

an authentication information verifying module configured to access the authentication parameter storage unit, determine that the information of the authentication image acquired by the authentication information acquiring module is information of an image generated by the authentication image generating module, and determine whether or not the authentication information stored in the authentication terminal matches the authentication information stored in the authentication information storage unit, and then transmit those results to the communication terminal (col. 11, lines 39-50).

As to claims 2 and 10, Saada discloses:

wherein the authentication parameter generated by the authentication image generating module includes at least one of a uniquely identifiable random number and a date (col. 9, lines 17-20).

As to claims 5 and 13, Saada discloses:

wherein the information of the authentication image is information obtained at the authentication terminal, by decoding the authentication image acquired from the communication terminal (col. 10, lines 37-40).

As to claims 6 and 14, Saada discloses:

wherein the information of the authentication image is information resulting from decoding the authentication image acquired from the communication terminal and received from the authentication terminal (col. 10, lines 37-40).

As to claims 7 and 15, Saada discloses:

wherein the authentication terminal takes and decodes an authentication image presented at the communication terminal to acquire the information of the authentication image from the communication terminal (col. 10, lines 37-40).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims 3, 8, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saada as applied to claims 1 and 9 above, and further in view of Matsuyama et al. (US 2002/0026581 A1 and Matsuyama hereinafter).

As to claims 3 and 11, Saada does not disclose:

wherein the authentication image generating module further stores an effective date of the authentication parameter in the authentication parameter storage unit;

the authentication information verifying module authorizes authentication when a date acquired by the authentication information acquiring module is before the effective date of the authentication parameter stored in the authentication parameter storage unit, and denies authentication when the date acquired by the authentication information acquiring module is after the effective date of the authentication parameter.

Nonetheless, these features are well known in the art and would have been an obvious modification of the teachings disclosed by Saada, as evidenced by Matsuyama.

Matsuyama discloses a system and method for content distribution, the system and method having:

wherein the authentication image generating module further stores an effective date of the authentication parameter in the authentication parameter storage unit (0634, lines 1-4);

the authentication information verifying module authorizes authentication when a date acquired by the authentication information acquiring module is before the effective date of the authentication parameter stored in the authentication parameter storage unit, and denies authentication when the date acquired by the authentication information acquiring module is after the effective date of the authentication parameter (0635, lines 14-19; 0638, lines 12-15; 0642, lines 15-17).

Given the teaching of Matsuyama, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Saada with the teachings of Matsuyama by performing authentication based on a stored effective date. Matsuyama recites motivation by disclosing that setting a validity period for information used for authentication allows for the examination of users at scheduled intervals and prevents the data from being used in a limitless period (0632, lines 1-11). It is obvious that the teachings of Matsuyama would have improved the teachings of Saada by limiting when authentication data is valid in order to allow scheduled examinations.

As to claims 8 and 16, Saada discloses:

the authentication information verifying module transmits the results to the content providing server (col. 11, lines 49-50).

Saada does not disclose:

wherein the information processing system further comprises a content providing server configured to provide content to the communication terminal;

the authentication image generating module receives from the content providing server an authentication request for the communication terminal.

Nonetheless, these features are well known in the art and would have been an obvious modification of the teachings disclosed by Saada, as evidenced by Matsuyama.

Matsuyama discloses:

wherein the information processing system further comprises a content providing server configured to provide content to the communication terminal (0526, lines 1-3);

the authentication image generating module receives from the content providing server an authentication request for the communication terminal (0522, lines 1-7).

Given the teaching of Matsuyama, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Saada with the teachings of Matsuyama by using a server to provide content through authentication. Matsuyama recites motivation by disclosing

that a content distribution system allows user authentication to be performed to identify a user in content transaction by distributing content with a secure container (Abstract, lines 1-4). It is obvious that the teachings of Matsuyama would have improved the teachings of Saada by providing content through authentication in order to ensure that a user is entitled to access the content.

20. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saada as applied to claims 1 and 9 above, and further in view of Iwami (US 2002/0156867 A1).

As to claims 4 and 12, Saada discloses:

wherein the authentication image generating module transmits the authentication image to the communication terminal via a first communication network (col. 4, lines 43-46; col. 7, lines 38-42).

Saada does not disclose:

the authentication information acquiring module acquires from the authentication terminal via a second communication network different from the first communication network, the information of the authentication image and the authentication information.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Saada, as evidenced by Iwami. Iwami discloses a system and method for managing access to storage resources, the system and method having:

the authentication information acquiring module acquires from the authentication terminal (i.e. source outside data center) via a second communication network (i.e. network outside data center) different from the first communication network, the information (i.e. packet) of the authentication image and the authentication information (0031, lines 15-19; 0034, lines 25-26; 0036, lines 5-9).

Given the teaching of Iwami, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Saada with the teachings of Iwami by receiving information through a different network. Iwami recites motivation by disclosing that a data center can conceal the identity of the storage devices in order to provide privacy to both user and storage provider (Abstract, lines 9-12). It is obvious that the teachings of Iwami would have improved the teachings of Saada by using a different network to transfer authentication information in order to provide privacy to both sender and recipient.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Su whose telephone number is (571) 270-3835. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Su/
Examiner, Art Unit 2431

/Christopher A. Revak/
Primary Examiner, Art Unit 2431